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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,666	08/01/2006	Brian John Higgins	4623-053150	3792
28289 7590 10/14/2010 THE WEBB LAW FIRM, P.C. 700 KOPPERS BUILDING 436 SEVENTH AVENUE PITTSBURGH, PA 15219			EXAMINER SMITH, NKEISHA	
			ART UNIT 3632	PAPER NUMBER
			MAIL DATE 10/14/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/553,666	Applicant(s) HIGGINS, BRIAN JOHN	
	Examiner NKEISHA J. SMITH	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-9 and 11-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-9 and 11-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The following correspondence is a non-final Office Action for application no. 10/533,666 for a GUTTER AND MOUNTING DEVICE FOR BUILDINGS, filed on 10/17/2005. This correspondence is in response to applicant's request for continued examination filed on 10/1/2010. Claims 7-9 and 11-36 are pending.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/1/2010 has been entered.

Priority

3. Applicant is advised of possible benefits under 35 U.S.C. 119(a)-(d), wherein an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country.

4. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 7-9, 11-15, 25-27, 29-31, 34 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Claim 7 contains the limitation wherein "the gutter part [is] received in the gutter". This limitation is unclear because the claim is interpreted such that the term, "the gutter part", is the same member as "part of the gutter" referred to previously therein. If such is the case, it is unclear how the gutter part or a part of the gutter is also received in the gutter because a "part" of the gutter is the gutter and, thus, cannot be received in the gutter. Appropriate clarification is requested. Claims 8, 9, 11-15, 27, 30 and 31 are rejected for the same reasons as dependent on claim 7.

8. Claim 8 recites the limitation "the other leg" therein. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 25 recites the limitation "the legs" therein. There is insufficient antecedent basis for this limitation in the claim. Claims 26, 29, 34 and 35 are rejected for the same reasons as dependent on claim 25.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

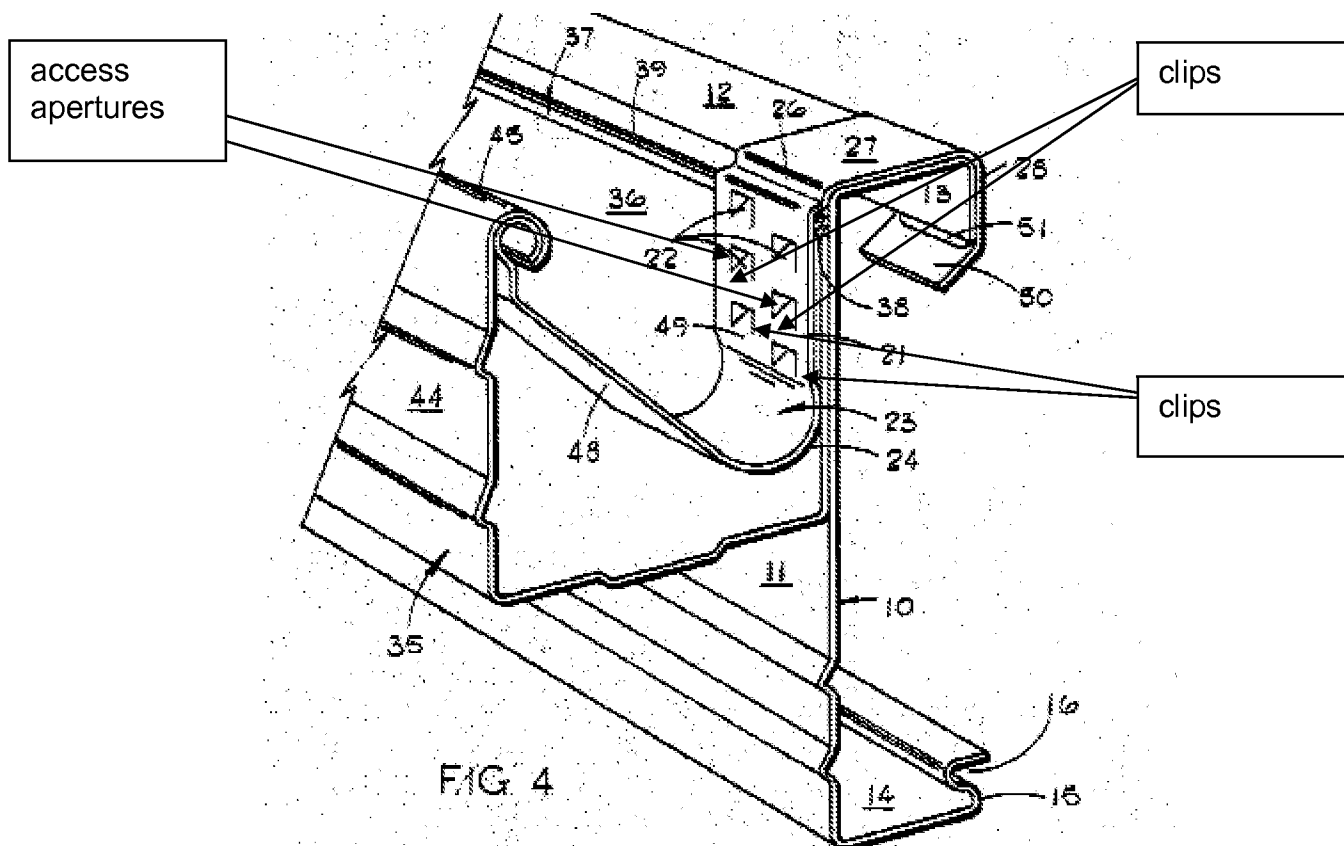
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 7-9 and 11-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Lasscock (3,864,882).

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Regarding claim 7, as best understood, Lasscock teaches a mounting device (Figs. 1, 2), the mounting device including an elongated device body (20) that extends in a second longitudinal direction between opposite ends, the body including an attachment section (28) and a gutter mounting section (21), wherein said elongated body includes a generally U-shaped portion, legs of the U-shaped portion being spaced apart so as to provide a recess therebetween for closely receiving part of the gutter with opposite surfaces of the gutter part being in facing relation with respective legs of the U-shaped portion, the gutter mounting section including a plurality of gutter retaining clips (tabs located in area as shown below) spaced apart from one another in the second longitudinal direction and extending into the recess (Fig. 1), the retaining clips being adapted to cooperate with the gutter part received in the gutter to retain the gutter to the mounting device, wherein the mounting device is configured such that when the gutter is retained to the mounting device, the second longitudinal direction of the elongated device body is substantially parallel to the first longitudinal direction of the gutter.



Regarding claim 8, as best understood, Lasscock teaches the device of claim 7, wherein one leg of the U-shaped portion is the attachment section and the other leg is the gutter mounting section.

Regarding claim 9, as best understood, Lasscock teaches the device of claim 8, wherein the gutter retaining clips include projections which extend into the recess.

Regarding claim 11, as best understood, Lasscock teaches the device of claim 9, wherein said projections are hook-like elements. The examiner notes that this claim involves improper method limitations, because the claim is directed to an apparatus, which are not given any patentable weight.

Regarding claim 12, as best understood, Lasscock teaches the device of claim 8, further including a plurality of access apertures (holes located in gutter mounting section through which elements 22 are connected) in the gutter mounting section.

Regarding claim 13, as best understood, Lasscock teaches the device of claim 7, wherein the retaining clips are aligned at an angle with respect to a single edge of the mounting device.

Although claim 14 recites purely functional limitations, as best understood, Lasscock teaches the device of claim 7, wherein the attachment section is capable of receiving fasteners.

Regarding claim 15, as best understood, Lasscock teaches the device of claim 8, wherein the body is channel shaped and is generally U-shaped in cross-section transverse to the longitudinal direction.

Regarding claim 16, Lasscock teaches a gutter and mounting device (Figs. 1, 2), the gutter (35) comprising a generally channel or trough shaped body with an inner wall (36) having a gutter mounting (39) thereon, and the gutter extending in a first longitudinal direction, the mounting device including an elongated device body (20) that extends in a second longitudinal direction between opposite ends, the body including an attachment section (28) which is attachable to the building and a gutter mounting section (21), wherein said elongated body includes a generally U-shaped portion, legs of the U-shaped portion being spaced apart so as to provide a recess therebetween for closely receiving the inner wall of the gutter in an installed position with opposite surfaces of the inner wall being in facing relation with respective legs of the U-shaped

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portion, the gutter mounting section including a plurality of gutter retaining clips (tabs located in area as shown below) spaced apart from one another in the second longitudinal direction (Fig. 1), the retaining clips being adapted to cooperate with the gutter mounting to retain the gutter to the device in the installed position, wherein the mounting device is configured such that when the gutter is retained to the mounting device, the second longitudinal direction of the elongated device body is substantially parallel to the first longitudinal direction of the gutter.

Regarding claim 17, Lasscock teaches the gutter and device of claim 16, wherein one leg of the U-shaped portion is the attachment section and the other leg is the gutter mounting section.

Regarding claim 18, Lasscock teaches the gutter and device of claim 17, wherein the gutter retaining clips include projections which extend into the recess and are adapted to cooperate with the gutter mounting on the inner wall of the gutter.

Regarding claim 19, Lasscock teaches the gutter and device of claim 18, wherein the gutter mounting on the inner wall of the gutter is a raised elongated rib which, when the gutter is in the installed position, is disposed within the recess and inhibited from removal by said projections (Fig. 2).

Regarding claim 20, Lasscock teaches the gutter and device of claim 18, wherein said projections are hook-like elements pressed or punched out of the gutter mounting section. The examiner notes that this claim involves improper method limitations, because the claim is directed to an apparatus, which are not given any patentable weight.

Regarding claim 21, Lasscock teaches the gutter and device of claim 18, further including a plurality of access apertures in the gutter mounting section.

Regarding claim 22, Lasscock teaches the gutter and device of claim 16, wherein the retaining clips are aligned at an angle with respect to a single edge of the mounting device corresponding to an angle of a fall required when the gutter is in the installed position.

Although claim 23 recites purely functional limitations, Lasscock teaches the gutter and device of claim 16, wherein the attachment section is capable of receiving fasteners.

Regarding claim 24, Lasscock teaches the gutter and device of claim 16, wherein the body is channel shaped and is generally U-shaped in cross-section transverse to the longitudinal direction.

Regarding claim 25, as best understood, Lasscock teaches a method of installing a gutter that extends in a first longitudinal direction, comprising the steps of: attaching a mounting device to a surface of a building (10), the mounting device comprising an elongated device body including a generally U-shaped portion, legs of the U-shaped portion being spaced apart so as to provide a recess therebetween for closely receiving part of the gutter (39) with opposite surfaces of the gutter part (opposite faces of member 36) being in facing relation with respective legs of the U-shaped portion, the body extending in a second longitudinal direction between opposite ends and including a plurality of retaining clips that extend into the recess, the mounting device being positioned on the building so that the U-shaped portion is disposed adjacent to the

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surface of the building and the clips are aligned so as to correspond to an angle of a fall required when the gutter is in an installed position; and mounting the gutter to the device by moving the gutter to the installed position where an inner wall of the gutter extends into the recess (36) the retaining clips cooperate with the gutter to retain the gutter in the installed position, when in the installed position, the first longitudinal direction of the gutter is substantially parallel to the second longitudinal direction of the elongated device body.

Regarding claim 26, as best understood, Lasscock teaches the method of claim 25, wherein the retaining clips of the mounting device are aligned at an angle with respect to a single edge of the mounting device corresponding to the angle of the fall, and the step of attaching the mounting device to the building further comprises aligning the single edge of the mounting device to an edge of the building.

Regarding claims 27 and 28, as best understood, Lasscock teaches the device of claims 7 and 16, wherein at least two retaining clips of the mounting device are aligned.

Regarding claim 29, as best understood, Lasscock teaches the method of claim 25, wherein at least two retaining clips of the mounting device are aligned, engage the gutter, and the step of attaching the mounting device to the building further comprises mounting the gutter to the mounting device such that at least two retaining clips simultaneously engage the gutter.

Regarding claims 30-33, as best understood, Lasscock teaches the device of claims 7 and 16, wherein the gutter mounting section includes a plurality of access

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apertures (holes as shown in the figure above) in an alternating arrangement with the mounting clips.

Regarding claims 34 and 35, as best understood, Lasscock teaches the method of claim 25, wherein the gutter mounting section includes a plurality of access apertures (holes as shown in the figure above) in an alternating arrangement with the mounting clips.

Regarding claim 36, Lasscock teaches the device of claim 22, wherein at least two retaining clips of the mounting device are aligned.

Response to Arguments

12. Applicant's arguments filed 10/1/2010 have been fully considered but they are either moot or not persuasive.

Applicant states that the prior art Lasscock reference does not teach all of the claims limitations of independent claims 7, 16 and 25. The Examiner respectfully disagrees. In response to applicant's argument that, as a result of the way the clip is fitted to the fascia, the spacing between the legs of the clip is not dimensioned to be arranged for "closely receiving" the gutter, the Examiner states that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The term "close" is defined as "having the parts or elements near to one another", and is a subjective term. Therefore, it is the Examiner's position that, as shown in Figs. 1 and 2, the spacing between the legs of the

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clip is dimensioned to be arranged for "closely receiving" the gutter because the clip is located near the gutter. Since the clip is located near the gutter, the spacing between the legs of the clip is dimensioned to be arranged for "closely receiving" the gutter, thereby meeting the functional limitations.

In addition, applicant argues that the clip of Lasscock does not allow for fixing directly to a structure or cannot be mounted on any outward supporting surface. It is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, because Lasscock teaches the exact same structure as set forth in applicant's claims, it is the Examiner's position that the clip of Lasscock can perform the same function.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NKEISHA J. SMITH whose telephone number is (571)272-5781. The examiner can normally be reached on Monday - Friday, 7:30 a.m. - 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrell McKinnon can be reached on (571) 272-4797. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NKEISHA J. SMITH/
Examiner, Art Unit 3632

October 12, 2010